

Remarks:

Claims 1, 2, 4-11, and 13-16 are pending. Claims 1, 2, 4-11, and 13-15 are rejected under 35 U.S.C. 112, first paragraph. Claims 1, 2, and 4-8 are rejected under 35 U.S.C. 112, second paragraph. Claims 1, 2, 4-11, and 13-16 are rejected under 35 U.S.C. 103(a).

Claims 1-16 and 21 are rejected under 35 U.S.C. §103. This application is amended by the virtue of this response, pursuant to 37 CFR 1.116. Please amend claims 1 and 9. Please cancel claim 11. No new matter is added. Support for the amended or the new claims is provided within the specification and the claims as filed.

The Applicant is not conceding that the subject matter recited in the amended or canceled claims is not patentable over the art cited by the Examiner. The amended, withdrawn or cancelled claims are provided solely to facilitate expeditious prosecution of the allowable subject matter. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by the amended or cancelled claims in one or more continuing applications.

Claim of Priority:

Applicant notes that the Examiner has not acknowledge the Applicant's claim of foreign priority under 35 U.S.C. § 119(a). None of the boxes were marked on the Office Summary page. Please let us know if all, some or none of the copies have been received. The Examiner indicates that he has previously checked the boxes. The Examiner is reminded that he has a duty to continue checking the appropriate boxes in each action to avoid any confusion on the record. The Examiner's compliance is respectfully requested.

Figures:

Applicant notes that none of the boxes were marked on the Office Summary page to indicate that the Examiner has accepted the Drawings. The Examiner indicates that he has previously checked the boxes. The Examiner is reminded that he has a duty to continue checking the appropriate boxes in each action to avoid any confusion on the record. The Examiner's compliance is respectfully requested. These amendments are supported by

paragraphs [0048], [0049], [0051] and [0054] in patent application publication of the present invention.

§112 Rejection(s):

Claims 1-2, 4-11 and 13-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner contends that claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Independent claims 1 and 9 recites "generating ring back tone data independently". The Examiner contends that this element and precisely the use of "independently" is not taught anywhere in the Applicant's specification. Further, dependent claims 2, 4-8, 10-11 and 13-16 are rejected for the same reasons.

This rejection is respectfully traversed as support for the rejected language is provided in paragraphs [0051] and [0054] of the Application as filed. The Examiner is reminded that §112, first paragraph, requires for the specification to adequately support the subject matter claimed rather than mirroring the claim language word for word. MPEP 2163, *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116.

Support can be provided “in a variety of ways” and “using such descriptive means as words, structures, figures, diagrams, and formulas” to “show that the applicant was in possession of the claimed invention. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997). See, e.g., *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 68, 119 S.Ct. 304, 312, 48 USPQ2d 1641, 1647 (1998) (emphasis added).

Further, claim limitations may be supported in the specification through “express, implicit, or inherent disclosure.” See *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971). Contrary to the Examiner’s understanding, section §112, first paragraph does not require a word-for-word matching between the language in the specification and the language recited in the claims. If one were to interpret §112, first paragraph, according to the Examiner’s

understanding, then the claim language would have to be limited to *identical* language used in the specification and nothing more.

Referring to MPEP 2163 (II) (A), “[t]he examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. There is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed, *Wertheim*, 541 F.2d at 262, 191 USPQ at 96.”

The application as filed supports the rejected claim language. The figures also provide the details of a mobile communication terminal and the nature of its use. See paragraphs [0051] and [0054] of the Application as filed. A reasonable person, after reviewing the entire disclosure and drawings would clearly understand that the claimed features. Respectfully, the Examiner has misinterpreted the requirements of §112 in rejecting the claims. Pursuant to MPEP §2163 (II) (A) and §2163.04, the Examiner is requested to present “evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims,”¹ or otherwise withdraw the rejection.

Regardless, the claims have been amended to recite “a first terminal generates ring back tone data without any help from a PSTN switchboard or an access gateway”. This technical feature is supported by paragraphs [0051] and [0054] in patent application publication of the present invention.

Claims 1-2 and 4-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claim 1, recites "generating ring back tone data independently by the first terminal, if the type of the network is a public switched telephone

¹ MPEP § 2163.04 "If applicant ... points out where and/or how the originally filed disclosure supports the amendment(s), and the examiner finds that the disclosure does not reasonably convey that the inventor had possession of the subject matter of the amendment at the time of the filing of the application, the examiner has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims.").

network". The Examiner contends that it is unclear whether the ring back tone still is generated by the first terminal if the type of network is *not* a public switched telephone network.

As amended, the claims recite "if the type of the network is not the PSTN, the second terminal generates the ring back tone by itself". The amended language is supported by paragraph [0020] in patent application publication of the present invention. This rejection is now moot by the virtue of this amendment.

The Examiner also contends that there is insufficient antecedent basis for "the response message." This rejection is respectfully traversed. Claim 1, as amended, recites "inserting the ring back tone data into a response message after reading out the ring back tone data from the buffer." This rejection is now moot by the virtue of this amendment.

§103 Rejection(s):

Claims 1-2, 4-11 and 13-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pub. No. 2003/0002476 to Chung et al. (hereafter "Chung"), in view of U.S. Patent No. 7,457,278 to Son et al. (hereinafter "Son") in further view of U.S. Patent No. 7,075,951 (McClary). Claims 8-9 and 11 are rejected for the same reasons as discussed above with respect to claim 1. The rejections are respectfully traversed.

Son Is an Improper Reference:

It is respectfully noted that Son is an improper reference in that it does not qualify as a prior art reference under 35 U.S.C. §103. Neither the filing date, the publication date, or the 371(c)(1) date associated with Son predate the effective filing date of the present application which claims priority to Korean Patent Application P2002-61051 filed on Oct. 7, 2002. Accordingly, for this reason alone, it is requested that the pending 103 rejection to be withdrawn.

The Examiner contends that the priority date of Son predate the effective filing date of the current application. It is respectfully noted, however, that the priority filing date of Son is immaterial for the purpose of rejecting the present application under section 103. It is

respectfully requested that the Examiner studies the "Hilmer doctrine."² The Hilmer doctrine stands for the proposition that the disclosure of an issued patent in the United States is *only* available as prior art under section 102(e) against other United States applicants as of its filing date as a United States national application.³ In other words, the effective date of a reference under section 103 cannot be based on its "priority date" from a foreign national application, or the filing date of an international PCT application from which priority is claimed, unless it complies with provisions of section 102(e) which provides that a person shall be entitled to a patent unless:

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in *section 351(a)* shall have the effects for the purposes of this subsection of an application filed in the United States *only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.* (Emphasis added.)

For the above reasons, unless the Examiner can provide proof that Son satisfies the above-noted requirements, Son is an improper reference and should be withdrawn.

Further, it has been long held that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

In other words, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge

² The "Hilmer doctrine" was established in *In re Hilmer*, 359 F.2d 859 (C.C.P.A. 1966) (Hilmer I) and was discussed further in *In re Hilmer*, 424 F.2d 1108 (C.C.P.A. 1970) (Hilmer II).

³ *Hilmer I*, 359 F.2d at 879.

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Further, according to MPEP §2143,⁴ to establish a prima facie case of obviousness, the Examiner must clearly articulate the reason(s) why the claimed subject matter would have been obvious at the time of invention. Exemplary rationales that may support a conclusion of obviousness include:

- (a) Combining prior art elements according to known methods to yield predictable results;
- (b) Simple substitution of one known element for another to obtain predictable results;
- (c) Use of known technique to improve similar devices (methods, or products) in the same way;
- (d) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; etc.

The claimed subject matter is directed to a method of generating a ring back tone at a first terminal communicating over a voice over internet protocol (VOIP) network, the method comprising: receiving a call setup request from a second terminal; identifying a type of a network to which the second terminal belongs; generating ring back tone data without any help from a public switched telephone network (PSTN) switchboard or an access gateway, if the type of the network is PSTN; storing the generated ring back tone data in a buffer; inserting the ring back tone data into a response message after reading out the ring back tone data from the buffer; and transmitting the response message to the second terminal in response to the call setup, wherein the ring back tone is inserted into the response message according to a first-in first-out method, wherein the VOIP and the PSTN networks are connected by way of a trunk gateway, wherein the response message is transmitted to the second terminal through a port informed by the trunk gateway during the call setup, wherein the second terminal receives the response message and generates a ring back tone by using the ring back tone data included in the response message, wherein the second terminal generates the ring back tone by itself, if the network is not a PSTN network.

⁴ *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739-1741, 82 USPQ 2d 1385, 1395-97 (2007).

It is noteworthy that in the claims “[a] functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.” MPEP § 2173.05. As provided in further detail below, the cited references fail to teach and suggest all the above-noted elements and functional relationship recited in the pending claims.

Chung discloses a gateway call routing system used to route calls, wherein the gateway connects a PSTN and the Internet. The call routing system includes a first computer connection module for connecting to a computer terminal, such as an Internet voice terminal, of a calling party, and a first phone connection module for connecting to a phone terminal of the calling party. In addition, the call routing system includes a second computer connection module for connecting to a computer terminal of a called party, and a second phone connection module for connecting to a phone terminal of the called party. Further, the call routing system includes a voice tuning module which sets voice tuning to a phone-to-phone mode if the terminal of the calling party is a phone and the terminal of the called party is also a phone, to a computer-to-phone mode if the terminal of the calling party is a computer and the terminal of the called party is a phone, to a phone-to-computer mode if the terminal of the calling party is a phone and the terminal of the called party is a computer, and to a computer-to-computer mode if the terminal of the calling party is a computer and the terminal of the called party is also a computer. In particular, Chung teaches a terminal at a PSTN configured to transfer a ring signal in response to a receiving connection.

It is respectfully submitted that Chung directly teaches away from the first terminal independently generating ring back tone data, as recited in claim 1. Chung suggests that a ring signal (i.e., the ring back tone data) is generated by PSTN 114 and sent to the calling party. See paragraph [0023] and figure 3. In contrast, claim 1 recites that the ring back tone is independently generated by the by the first terminal without any help from a PSTN switchboard or access gateway. See Specification, paragraph [0052]. Therefore, a person of ordinary skill in the art could not be motivated to combine Chung with any other reference as the resulting

combination would also teach away from the first terminal independently generating ring back tone data.

Son fails to cure the deficiencies of Chung. Son discloses a VoIP gateway that serves to send a connection request to either the IP network or the PSTN on the basis of the information stored in the VOIP gateway and the destination telephone number contained in the connection request as sent from the telephone terminal. If a connection request is decided to be sent to the IP network, the VOIP gateway sends the connection request to the PSTN when the IP network state judgment unit judges that the communication through the IP network is impossible. Furthermore, if a destination telephone number includes predetermined identification information, the VOIP gateway can forcibly send the connection request to the PSTN. Son fails to suggest generating ring-back tone when the type of the network is a public switched telephone network, as claimed. Particularly, Son only discloses that the VOIP gateway transmits a ring back tone to the telephone terminal.

McClary fails to cure the deficiencies of Chung and Son. Particularly, McClary is directed to a storage unit to store data from a data signal, and a control circuitry coupled to the storage unit. The control circuitry is to cause the storage of the data from the data signal into the storage unit at a nominal rate upon determining that the data signal includes a number of errors.

Chung, Son and McClary, either alone or in combination fail to disclose that a first terminal communicating over a VOIP network generates ring back tone data independent of a PSTN switchboard or an access gateway when the type of the network is a PSTN. Further, neither of the references teach that the second terminal generates the ring back tone by itself, if the type of the network is not the PSTN. It is respectfully noted that §103 does not allow the Examiner to engage in a picking and choosing from the prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art. *In re Wesslau*, 147 USPQ 391 (CCPA 1975).

The question of whether a cited reference can properly be modified in a §103 rejection is not whether a particular limitation was known at time of invention, but rather whether there is a reason that would make it obvious for one of ordinary skill in the art at the time of the invention to modify the cited reference to include that particular limitation. As the U.S. Supreme Court has affirmed, "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art... it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ 2d 1385, 1397 (2007).

Additionally, it is improper to use Applicant's disclosure as a road map for selecting and combining prior art references. See *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907 (Fed. Cir. 1988). Applicant respectfully submits that in the absence of any legitimate reason that it would be obvious to combine the cited references, the Office Action has used Applicants' claims as a road map for modifying the cited reference.

While the suggestion to modify this reference may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Appellant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. *In re Geiger*, 2 USPQ2d 1276 (Fed. Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and

teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicant invites the Examiner to point out the alleged motivation to combine with specificity,⁵ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.⁶

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the §103 rejection be withdrawn. For the above reasons, none of the cited references, either alone or in combination, teach or suggest all the elements recited in the claims. Therefore, it is respectfully submitted that the claims are in condition for allowance.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to contact the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 or jfar-hadian@lhlaw.com to discuss the steps necessary for placing the application in condition for allowance.

⁵ *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

⁶ "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

Respectfully submitted,
LEE, HONG, DEGERMAN, KANG & WAIMEY

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